

Appn No.: 09/388,351

Petition for Withdrawal of Premature Final Rejection

In Reply to Office Action of: July 16, 2003

SEP 16 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

PT & TRADEMARK OFFICE  
In the Application of: **Snapper et al.**) Atty. Docket No.: 003797.77746  
Serial No.: 09/388,351 ) ) Group Art Unit: 2176  
Filed: September 1, 1999 ) ) Examiner: Charles A. Bieneman  
For: System and Method for Populating ) ) Confirmation No.: 3809  
Forms with Previously Used Data  
Values

**PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION**  
**UNDER 37 C.F.R. § 1.181**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition for withdrawal of the final rejection of the above named application under 37 C.F.R. § 1.181.

MPEP § 706.07(a) states that second actions on the merits shall be final except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an Information Disclosure Statement (IDS). It further states that a second action will not be made final if it includes a rejection, on newly cited art, other than information filed in an IDS filed under 37 C.F.R. 1.97(c), of any claim not amended by Applicants in spite of the fact that other claims may have been amended to require newly cited art.

The Final Office Action dated July 16, 2003 was thus premature for the following reasons.

There were two independent claims, Claims 16 and 21, that were not amended in Applicants' Amendment dated June 16, 2003 in response to a first Office Action dated December 19, 2002. Claim 16 was originally rejected under 35 U.S.C. § 103(a) as being unpatentable over Light et al. in

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view of Atlas et al. Claims 16 was subsequently rejected under § 103(a) as being unpatentable over Light et al. in view of Capps, new grounds that were neither necessitated by amendment of the claims, nor based on information submitted in an IDS. Capps was originally cited in the Notice of References cited accompanying the first Office Action dated December 19, 2002, thus the rejection could have been made in the first office action, but was not.

Similarly Claim 21 was originally rejected under 35 U.S.C. § 103(a) as being unpatentable over Atlas et al. in view of Light et al. Claim 21 was subsequently rejected under § 103(a) as being unpatentable over Kikinis in view of Light et al. Kikinis was originally cited in the Notice of References cited accompanying the first Office Action dated December 19, 2002, thus the rejection could have been made in the first office action, but was not.

The Final Office Action cited Applicants' filing of a declaration under 37 C.F.R. 1.131 as the cause of the new grounds for rejection. The Final Office Action cited no authority that a declaration under 37 C.F.R. 1.131 constitutes an amendment as required by the MPEP.

Furthermore, Applicants' Amendment dated June 16, 2003 did not require the Examiner to conduct a new prior art search, and no references from any new search were used as new grounds for rejection in the Final Office Action.

The Commissioner is authorized to charge the requisite fee under 37 C.F.R. § 1.17(h) of \$130.00 to our Deposit Account No. 19-0733. Any deficiency in fees should also be charged to our Deposit Account No. 19-0733.

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Respectfully submitted,

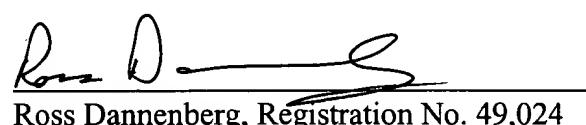
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BANNER & WITCOFF, LTD.

Technology Center 2100

Dated this 16 day of Sep., 2003

By:

  
Ross Dannenberg, Registration No. 49,024

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